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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/694,402	10/22/2000	John Thaddeus Pienkos		9105

7590

12/09/2005

PATENTBANK L.L.C. ATTN: John T. Pienkos  
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EXAMINER

BLECK, CAROLYN M

ART UNIT PAPER NUMBER

3626

DATE MAILED: 12/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/694,402

**Applicant(s)**

PIENKOS, JOHN THADDEUS

**Examiner**

Carolyn M. Bleck

**Art Unit**

3626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 07 November 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Notice to Applicant***

1. Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn.
2. This communication is in response to the amendment filed 7 November 2005. Claims 1-20 are pending.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-7 and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by Luchs et al. (4,831,526), for substantially the same reasons as given in the previous Office Action (dated 1/25/04).

(A) The amendments to claim 1 recite providing a field of an input of "at least one" limitation relating to a desired insurance coverage, the "at least one" limitation including a time period... and a geographical region. Previously claim 1 recited providing a field for an input of a limitation relating to a desired insurance coverage, the limitation including at least one of a time period... and a geographical region. These

Art Unit: 3626

amendments to claim 1 do not affect the scope and breadth of the claim as originally presented and/or in the manner in which the claim was interpreted by the Examiner when applying prior art within the previous Office Action.

As such the recited claimed features are rejected for the same reasons given in the prior Office Action (dated 1/25/05), and incorporated herein.

(B) Claims 2 and 4-7 have not been amended and are rejected for the same reasons given in the prior Office Action (paper dated 1/25/05).

(C) The amendments to claim 3 recite wherein the time period indication is specified by the input of a start time.... Previously claim 3 recited wherein the limitation is the time period indication, and the limitation is specified by the input of a start time.... These amendments to claim 3 do not affect the scope and breadth of the claim as originally presented and/or in the manner in which the claim was interpreted by the Examiner when applying prior art within the previous Office Action.

As such the recited claimed features are rejected for the same reasons given in the prior Office Action (dated 1/25/05), and incorporated herein.

(D) As per claim 9, Luchs discloses the insurance coverage relating to a automobile and a watercraft, such as a boat (col. 7-8 Table continued in col. 9-10).

***Claim Rejections - 35 USC § 103***

Art Unit: 3626

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Luchs et al. (4,831,526) as applied to claim 1, and further in view of Pescitelli et al. (5,845,256), for substantially the same reasons as given in the previous Office Action (dated 1/25/04).

(A) Claim 8 has not been amended and is rejected for the same reasons given in the prior Office Action (paper dated 1/25/05).

7. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Luchs et al. (4,831,526) as applied to claim 1, and further in view of Official Notice, for substantially the same reasons as given in the previous Office Action (dated 1/25/04).

(A) Claim 10 has not been amended and is rejected for the same reasons given in the prior Office Action (paper dated 1/25/05).

Art Unit: 3626

8. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Luchs et al. (4,831,526) as applied to claim 1, and further in view of Quicken (Quicken website, Accessed from [www.archive.org](http://www.archive.org), dated 12/12/1998).

(A) As per claim 11, Luchs does not disclose wherein the central processor is at least one of owned and operated at a direction of an insurance provider, and wherein each of the field and the confirmation is provided onto an internet communications link for receipt by a web client terminal that is at least one of owned and operated at a direction of an insurance carrier. Quicken discloses an insurance website for a customer to receive real-time quotes and purchase policies from the nation's leading insurance companies, wherein the customer enters information on a computer (reads on "client terminal") via a web browser over the Internet, wherein the Quicken system (reads on "insurance provider") receives information from multiple insurance companies and displays the quotes to a user (see pages 1-8). At the time the invention was made, it would have been obvious to one of ordinary skill in the art to include the features of Quicken within the method of Luchs with the motivation of providing a quick way to access insurance information using the Internet (pg. 2 of Quicken).

9. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Luchs et al. (4,831,526) as applied to claim 1, and further in view of Serdy (5,990,886), for substantially the same reasons as given in the previous Office Action (dated 1/25/04).

Art Unit: 3626

(A) The amendments to claim 12 recite wherein the input of the geographical region indication occurs by at least one of providing at least one map and receiving a demarcation indication which indicates a specific region on the map and receiving at least on selection of a geographical region from a list of possible geographical regions. It appears claim 12 requires "at least one of" these limitations. Thus, these amendments to claim 12 do not affect the scope and breadth of the claim as originally presented and/or in the manner in which the claim was interpreted by the Examiner when applying prior art within the previous Office Action.

As such the recited claimed features are rejected for the same reasons given in the prior Office Action (dated 1/25/05), and incorporated herein.

10. Claims 13-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Luchs et al. (4,831,526) in view of Felton (Felton, Bruce, "Rental Car Insurance: Staying out of financial potholes," The New York Times, March 23, 1997, pg. 3, 11).

(A) As per claim 14, Luchs discloses fully computerized insurance premium quote request and policy issuance method comprising:

(a) entering data into fields relating to a desired insurance coverage, wherein the fields include the effective data of the insurance policy, the expiration date of the insurance policy, and the zip code and state of the policy holder (Fig. 10A-B, col. 22 line 5 to col. 23 line 28);

(b) receiving at the central processor, which includes a databank, the information entered into fields (col. 2 line 55 to col. 3 line 5, col. 22 lines 5-35, col. 28 lines 20-52);

(c) electronically and automatically comparing the data in the insurance application to certain underwriting criteria before actually proceeding with the printing of the insurance application, wherein the underwriting criteria compared with data include the effective date, expiration date, and city/ country code (col. 7 line 28 to col. 20 line 50); and

(d) sending the policy to printing if the policy does not need further approval based on the criteria, and wherein if further approval is needed, the policy is sent to underwriting for approval (col. 16 lines 30-52).

Luchs includes the feature of receiving a customer specification setting time limits regarding a desired amount of insurance coverage (i.e., the effective date and the expiration date). However, Luchs does not include the feature of the time limit specifying a time period of less than a month. Felton discloses in his article that it is well known in the insurance arts to provide rental car insurance to customers, wherein the rental car insurance is limited to periods of time of 15 days or 30 days (pg. 2, par. 7).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to include the features of Felton within the method of Luchs with the motivation of allowing a customer to receive insurance only for the period of time in which they are using the rental car (pg. 2, par. 3).



Art Unit: 3626

(B) As per claim 13, Luchs discloses allowing a user to input geographical information such as a zip code, state, or city (Fig. 10A-B), wherein the user input is received via telephone lines (col. 13 lines 59-63).

11. Claims 15-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cullen et al. (6,272,528) in view of Luchs et al. (4,831,526) and Felton (Felton, Bruce, "Rental Car Insurance: Staying out of financial potholes," The New York Times, March 23, 1997, pg. 3, 11).

(A) As per claims 15-16, Cullen discloses a number of user computers connected to a plurality of server computers by way of a network, such as the Internet, wherein the user of the client computer enters data into the interface regarding preferences for an insurance quote (Abstract, Fig. 1, 4-7, col. 1 line 45 to col. 2 line 11, col. 4 line 64 to col. 5 line 4, col. 6 line 39 to col. 7 line 39) (An interface for use over the Internet is considered to be a form of "web page").

Cullen fails to expressly disclose allowing the user to specify a temporal limitation for an insurance policy, the temporal limitation specifying a time period less than a month, and allowing a user to specify a geographical limitation for the insurance policy, the geographical limitation specifying a geographical region that is smaller in size than an entire nation.

Luchs discloses entering data into fields relating to a desired insurance coverage, wherein the fields include the effective data of the insurance policy, the

expiration date of the insurance policy, and the zip code and state of the policy holder (Fig. 10A-B, col. 22 line 5 to col. 23 line 28).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to include the features of Luchs within the system of Cullen with the motivation of allowing a user to obtain information from a variety of sources over the Internet, thus reducing the difficulty in obtaining information on multiple insurance policies (Cullen; col. 1 lines 5-45).

Luchs includes the feature of receiving a customer specification setting time limits regarding a desired amount of insurance coverage (i.e., the effective date and the expiration date). However, Cullen and Luchs does not include the feature of the time limit specifying a time period of less than a month. Felton discloses in his article that it is well known in the insurance arts to provide rental car insurance to customers, wherein the rental car insurance is limited to periods of time of 15 days or 30 days (pg. 2, par. 7).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to include the features of Felton within the method of Cullen and Luchs with the motivation of allowing a customer to receive insurance only for the period of time in which they are using the rental car (pg. 2, par. 3).

(B) As per claim 17, Luchs discloses storing in a databank on a central processor, a client file which includes the client name and client address (Fig. 1, col. 6 lines 25-65). The motivation for combining Luchs within the system of Cullen is given above in claim 15.

(C) As per claim 18, Cullen discloses:

(a) wherein the user selects the "most suitable quotation" option which attempts to find an insurance policy which will give the best value based on the user's preferences, wherein the results of the search include presenting the results to the user in an interface (col. 7 lines 5-67, col. 11 line 10 to col. 12 line 35).

Cullen fails to expressly disclose wherein the input controls include a set of selectable menu items including at least one of a list of possible temporal limitations concerning possible time periods for insurance coverage, and a list of possible geographic limitations concerning possible regions for insurance coverage; and wherein the display provides, in response to the specifying of a temporal limitation a first confirmation when the server computer determines that insurance coverage can be provided during the time period corresponding to the temporal limitation; and wherein the display provides, in response to the specifying of a geographic limitation a second confirmation when the server computer determines that insurance coverage can be provided within the region corresponding to the geographic limitation.

Luchs discloses entering the city, state, county, and zip code, and an effective date, and expiration date for an insurance quotation into fields in forms (Fig. 10A-B, col. 21 lines 39-48, col. 22 lines 6-35). Further, Luchs discloses sending the policy to printing if the policy does not need further approval based on the criteria, and wherein if further approval is needed, the policy is sent to underwriting for approval (col. 16 lines 30-52).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to include the features of Luchs within the system of Cullen with the motivation of allowing a user to obtain information from a variety of sources over the Internet, thus reducing the difficulty in obtaining information on multiple insurance policies (Cullen; col. 1 lines 5-45).

Cullen and Luchs do not disclose selecting the information from a list. It is respectfully submitted that it is well known in the art of graphical user interfaces to present information in list form, and a person skilled in the art would have recognized this modification to the method taught collectively by Cullen and Luchs at the time the invention was made to ensure that users do not improperly enter information.

12. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cullen et al. (6,272,528), Luchs et al. (4,831,526), and Felton (Felton, Bruce, "Rental Car Insurance: Staying out of financial potholes," The New York Times, March 23, 1997, pg. 3, 11) as applied to claim 15, and further in view of Hartigan (0/205477).

(A) As per claim 19, Cullen, Luchs, and Felton fail to expressly disclose the user interface including an input means in which a new customer can specify information that is utilized to determine whether the new customer is eligible for obtaining insurance coverage of a particular type: and wherein upon the providing of the information by way of the input means, the user interface displays results that include an indication of whether the new customer is eligible for obtaining insurance coverage of the particular

Art Unit: 3626

type, and wherein, upon a determination that the new customer is eligible for obtaining insurance coverage of the particular type, the results that are displayed include an identification code including at least one of a user name and a password, and wherein, upon entry of the identification code by way of the user interface, the new customer is able to input at least one of the temporal limitation and the geographic limitation.

Hartigan discloses giving a permanent access code-password combination to each holder who requests a certificate, wherein each holder may enter its own insurance requirements, which Ins-cert.com compares to the viewed data and shows the holder exactly which parts of the insured's coverage do not comply (par. 1 lines 5-8).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to combine the teachings of Hartigan within the system taught collectively of Cullen and Luchs with the motivation of allowing a user to determine whether they are eligible for insurance coverage (Hartigan; par. 1 line 8).

The remainder of claim 19 repeats the limitations of claim 15, and are incorporated herein.

13. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Luchs et al. (4,831,526) and Felton (Felton, Bruce, "Rental Car Insurance: Staying out of financial potholes," The New York Times, March 23, 1997, pg. 3, 11) as applied to claim 14, and further in view of Quicken (Quicken website, Accessed from [www.archive.org](http://www.archive.org), dated 12/12/1998).

Art Unit: 3626

(A) As per claim 20, Luchs and Felton do not expressly disclose providing web page information onto the internet for receipt by a client computer, and also providing confirmation onto the internet that the desired insurance coverage can be provided for receipt by the client computer upon determining that the desired insurance coverage can be provided, wherein the customer specification is received off of the internet after being transmitted by a terminal, and wherein the computer is at least one of owned and operated in response to direction provided by at least one of an insurance company and an insurance provider, and wherein the terminal is at least one of owned and operated in response to direction provided by the customer.

Quicken discloses an insurance website for a customer to receive real-time quotes and purchase policies from the nation's leading insurance companies, wherein the customer enters information on a computer (reads on "client terminal") via a web browser over the Internet, wherein the Quicken system (reads on "insurance provider") receives information from multiple insurance companies and displays the quotes to a user (reads on "confirmation"), wherein upon the customer receiving the quotes, the customer is able to select the policy he or she would like and purchase the policy (see pages 1-8). At the time the invention was made, it would have been obvious to one of ordinary skill in the art to include the features of Quicken within the method of Luchs and Felton with the motivation of providing a quick way to access insurance information using the Internet (pg. 2 of Quicken).

### ***Response to Arguments***

14. Applicant's arguments with respect to claims 1-20 have been considered but are moot in view of the new ground(s) of rejection.

In response, all of the limitations which Applicant disputes as missing in the applied references, including the features newly added in the 7 November 2005 amendment, have been fully addressed by the Examiner as either being fully disclosed or obvious in view of the collective teachings of Luchs, Cullen, Felton, the Quicken Website, Hartigan, and/or Serdy, based on the logic and sound scientific reasoning of one ordinarily skilled in the art at the time of the invention, as detailed in the remarks and explanations given in the preceding sections of the present Office Action and in the prior Office Action (1/25/05), and incorporated herein. One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

### ***Conclusion***

15. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carolyn Bleck whose telephone number is (571) 272-6767. The Examiner can normally be reached on Monday-Thursday, 8:00am – 5:30pm, and from 8:30am – 5:00pm on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached at (571) 272-6776.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Art Unit: 3626

**17. Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks  
Washington, D.C. 20231

**Or faxed to:**

(571) 273-8300 [Official communications]

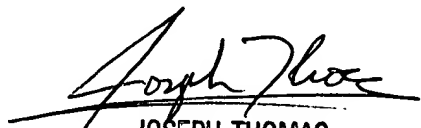
(571) 273-8300 [After Final communications labeled "Box AF"]

(571) 273-6767 [Informal/ Draft communications, labeled  
"PROPOSED" or "DRAFT"]

Hand-delivered responses should be brought to the Knox Building, Alexandria, VA.

  
CB

November 28, 2005

  
JOSEPH THOMAS  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600